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10/549,375	01/26/2007	Andrew Michael Wild	148392-110066	3476

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EXAMINER

DORNBUSCH, DIANNE

ART UNIT	PAPER NUMBER
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3773

NOTIFICATION DATE	DELIVERY MODE
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12/09/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patent-at@btlaw.com

Office Action Summary	Application No. 10/549,375	Applicant(s) WILD, ANDREW MICHAEL	
	Examiner DIANNE DORNBUSCH	Art Unit 3773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4, 11-22 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4, 11-22 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claim 22 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 16. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Objections

3. Claims 4 and 11-22 are objected to because of the following informalities: the claimed language "each limb" is not consistent with the language of claim 24. The limbs

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should be --first resilient arm and second resilient arm--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 4, 11-22 and 24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claim limitation of claim 24 that states that the axis of the body passageway is orthogonal to the first plane then it is at a non-orthogonal angle to the fourth plane is considered new matter since the first and fourth plane are seen as being parallel to each other but offset as seen in Fig. 1. The original disclosure does not show that the fourth plane is non-orthogonal when the first plane is orthogonal; hence it is considered new matter.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 4, 11-22 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 24 recites the limitation "the offsetting planes" in line 28. There is insufficient antecedent basis for this limitation in the claim.

It is unclear to the examiner what applicant is referring to as the "offsetting planes", however the examiner believes that applicant might be referring to the offsetting of the resilient legs.

Claim 24 states "when the axis of the body passageway is orthogonal to the first plane then it is at a non-orthogonal angle to the fourth plane," it is unclear to the examiner how the angle would be different since both planes are parallel but offset from each other as seen in the figures of the original disclosure.

Note that due to the 112 1st and 2nd issues regarding the first and fourth plane being orthogonal and non-orthogonal, this limitations will not be given patentable weight.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 4, 11, 14-16, 22, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Seckerson et al. (3,807,675).

Seckerson discloses the following claimed limitations:

Claim 24: A generally planar base portion (see figure below where the area filled is the base) defining a first plane (see figure below); a first resilient arm (12) extending from the base portion (figure below) and having a curved distal end portion (17) defining a

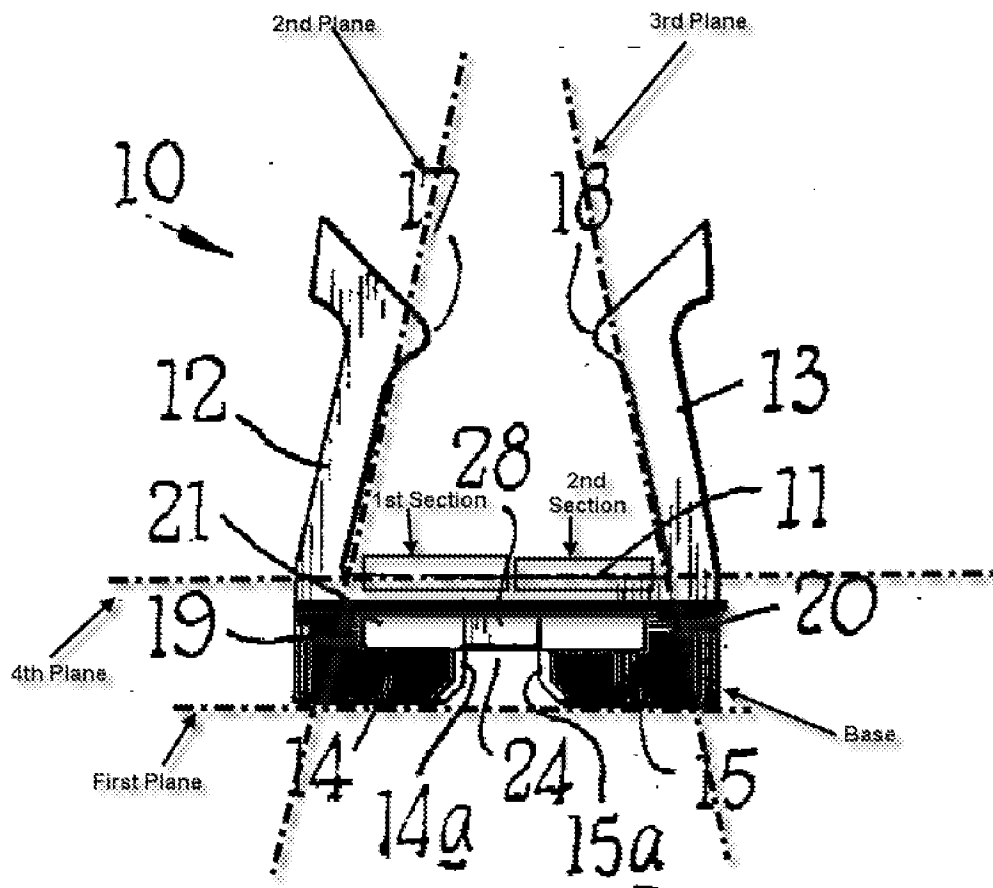
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first contact surface (inner surface of the arm and curved portion) and disposed in a second plane (see figure below) offset to a first side of the first plane (figure below and Fig. 6-7 where the contact surface is contacting part 16); a second resilient arm (13) extending from the base portion and having a curved distal end portion (18) defining a second contact surface (inner surface of the arm and curved portion) and disposed in a third plane (see figure below) offset to a second side of the first plane (figure below and Fig. 6-7 where the contact surface is contacting part 16), whereby the first and second contact surfaces curve generally toward each other (Fig. 6-7); and a third contact surface (11) defined by a section (the two sections as seen in the figure below form the section (Fig. 5)) extending from the base portion (see figure below), an elongate reaction surface (the reaction surface is the surface of 11 that contacts the part 16 which reacts by exerting a normal force on the part 16) and disposed on a fourth plane (see figure below) offset from the first plane and distinct from the second and third planes; whereby the third contact surface is disposed generally between the first and second arms when the clip is viewed parallel to the first plane (see figure below); whereby the first and second arms can pivot independently of the third contact surface (Fig. 1, 5-7), whereby the offsetting of the planes (examiner is interpreting it as the offset of the resilient legs which comprises that first resilient arm and the second resilient arm are offset from the third contact surface (Fig. 1 and 5)) such that in a closed condition of the clip, the first contact surface contacts the body passageway at a first longitudinal position on the body passageway, the second contact surface contacts the body passageway at a second longitudinal position and the third contact surface

contacts the body passageway at a third longitudinal position (Fig. 6-7), such that the body passageway is contacted at three longitudinally distinct locations by the first, second and third contact surfaces (Fig. 6-7), and whereby the co-operation of the first, second and third contact surfaces can compress the body passageway and substantially reduce the diameter of the body passageway, so as to substantially prevent the flow of fluid through the passageway.

With respect to the last statements, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Note that the device of Seckerson is capable of compressing a tube as claimed.

Furthermore, the device of Seckerson can receive the body passageway in an open condition between the third contact surface and the distal end portions of the first and second arms and the arms can close resiliently towards the third contact surface to a closed condition in which the base portion and the third contact surface oppose the distal end portions of the arms across the body passageway with the third contact surface contacting and compressing the body passageway from one side thereof and the first and second contact surfaces contacting and compressing the body passageway from the other side thereof (Fig. 6 where the passageway would be more compress depending on the tube material used such as a more flexible one than the clip can compress it more); the reaction surface and the arms being dimensioned and arranged



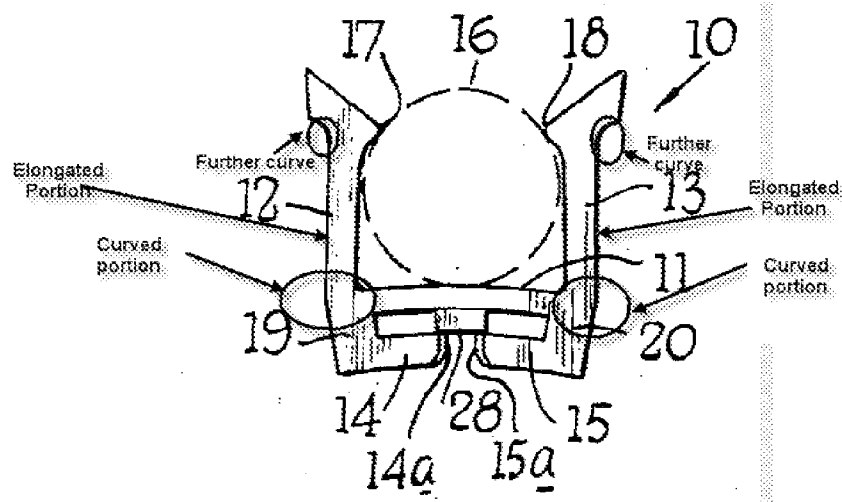
Claim 4: The reaction surface is substantially fixed in relation to the movement of the limbs (Fig. 5-7).

Claim 11: The reaction surface is shaped in a manner generally complementary to the shape of those parts of each limb which cooperate with the reaction surface in the closed condition of the clip (Fig. 1).

Claim 14: Each limb is connected to the base portion of the clip via a curved portion of the limb (see figure below) defining a connection point to the base portion behind the reaction portion of the clip (see figure below).

Claim 15: A further curve (see figure below) is provided in the limb in the opposite direction to the said curved portion, whereby the free end of the limb is disposed forward of the base portion of the clip (see figure below).

Claims 16 and 22: An elongate portion (see figure below) is provided in each limb between the curves (see figure below), whereby during closure a leverage effect is produced on the part of the limb which is in contact with the body passageway (Fig. 5-7).



10. Claims 17-20 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Esposito (3,616,497).

Esposito discloses the following claimed limitations:

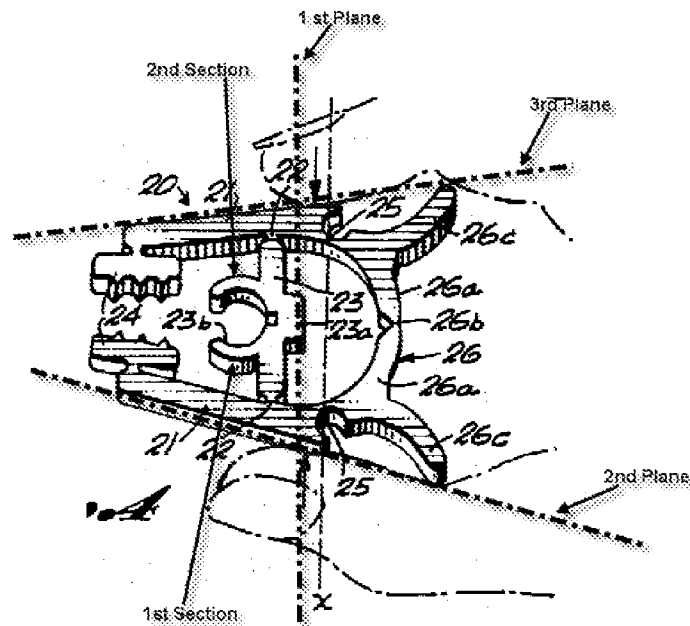
Claim 24: A generally planar base portion (23 and 23a) defining a first plane (see figure below); a first resilient arm (21) extending from the base portion (Fig. 3) and having a curved distal end portion (Fig. 3-4) defining a first contact surface (24) and disposed in a second plane (see figure below) offset to a first side of the first plane (figure below); a second resilient arm (21) extending from the base portion and having a curved distal end portion (18) defining a second contact surface (24) and disposed in a third plane (see figure below) offset to a second side of the first plane (figure below), whereby the first and second contact surfaces curve generally toward each other (Fig. 3-4); and a third contact surface (23b) defined by a section (the two sections as seen in the figure below form the section) extending from the base portion (see figure below), an elongate

reaction surface (23b) (Fig. 5) and disposed on a fourth plane (see figure below) offset from the first plane and distinct from the second and third planes; whereby the third contact surface is disposed generally between the first and second arms when the clip is viewed parallel to the first plane (see figure below); whereby the first and second arms can pivot independently of the third contact surface (Fig. 3-5), whereby the offsetting of the planes (examiner is interpreting it as the offset of the resilient legs which comprises that first resilient arm and the second resilient arm are offset from the third contact surface (Fig. 3-5)) such that in a closed condition of the clip, the first contact surface contacts the body passageway at a first longitudinal position on the body passageway, the second contact surface contacts the body passageway at a second longitudinal position and the third contact surface contacts the body passageway at a third longitudinal position (Fig. 5), such that the body passageway is contacted at three longitudinally distinct locations by the first, second and third contact surfaces (Fig. 5), and whereby the co-operation of the first, second and third contact surfaces can compress the body passageway and substantially reduce the diameter of the body passageway, so as to substantially prevent the flow of fluid through the passageway.

With respect to the last statements, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Note that the device of Esposito is capable of compressing a tube as claimed.

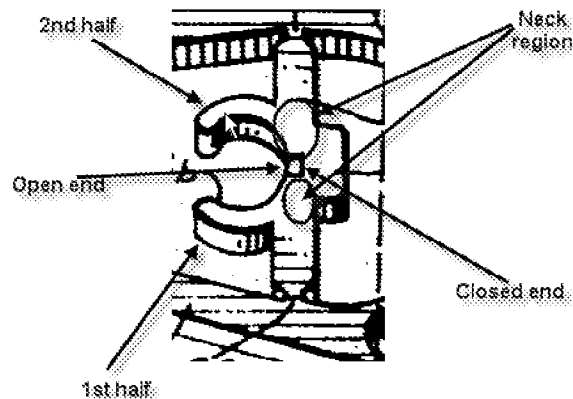
Furthermore, the device of Esposito can receive the body passageway in an open condition between the third contact surface and the distal end portions of the first and second arms and the arms can close resiliently towards the third contact surface to a closed condition in which the base portion and the third contact surface oppose the distal end portions of the arms across the body passageway with the third contact surface contacting and compressing the body passageway from one side thereof and the first and second contact surfaces contacting and compressing the body passageway from the other side thereof (Fig. 4-5 where the passageway would be more compress depending on the tube material used such as a more flexible one than the clip can compress it more. Furthermore, the tube can be hold by the resilient legs and depending on the diameter and wall thickness of the tube the third contact surface would also be contacting the tube); the reaction surface and the arms being dimensioned and arranged so that, in said closed condition of the clip, substantially the entire transverse width of the occluded body passageway is in contact with the reaction surface (Fig. 4-5).

With respect to the last statements, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).



Claim 17: The base portion of the clip is in the form of an open loop or generally U-shaped member (23a is in u-shape) having a closed end directed away from the limbs (see figure below) and an open end (see figure below) at which the limbs and the reaction portion are connected to the base portion (Fig. 3).

Claim 18: The reaction portion of the clip is provided in two halves (see figure below), each half is connected to one side of the open end of the base portion via a neck region (see figure below) and which are complementarily juxtaposed to define the reaction surface of the clip (see figure below).



Claim 19: The base portion of the clip is provided with a weak region or point (22) at which the base portion may be cut to remove the clip from the body passageway.

Regarding the last statement, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim 20: The clip is integrally formed of a superelastic or pseudoelastic shape memory material (Col. 3 Lines 5-10).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

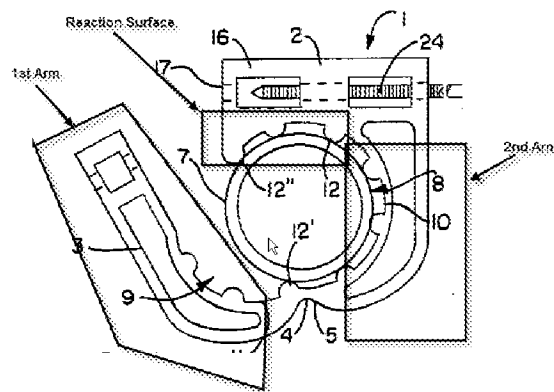
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12. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seckerson et al. (3,807,675) in view of Cirino et al. (6,164,604).

Claims 12 and 13:

Seckerson teaches all the claimed limitations discussed above however, Seckerson does not disclose surface projections on the resilient arms and reaction surface.

Cirino discloses a clip (1) with a base (2), first and second arms (see figure below), a reaction surface (see figure below); where the reaction surface and arms have surface projections (12) in the shape of rounded teeth (Fig. 1).



It would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide Seckerson with surface projections in view of the teachings of Cirino, in order to compressibly grip the exterior surface of the tubular member.

13. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Esposito (3,616,497).

Esposito discloses the claimed invention including that the device can be integrally formed of a plastic (Col. 3 Lines 5-10), however Esposito does not disclose that the clip can be integrally formed of nitinol metal. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the clip out of nitinol metal, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Response to Arguments

14. Applicant's arguments filed September 8, 2009 have been fully considered but they are not persuasive.

15. In response to applicant's argument that Seckerson, Esposito, nor Cirino discloses a device that can perform the limitations as claimed in claim 24, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

As explained above, both the devices of Esposito and Seckerson are capable of holding a tube-like body passageway and compressing it.

16. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Conclusion

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DIANNE DORNBUSCH whose telephone number is (571)270-3515. The examiner can normally be reached on Monday through Thursday 7:30 am to 5:00 pm Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. D./

Examiner, Art Unit 3773

/(Jackie) Tan-Uyen T. Ho/

Supervisory Patent Examiner, Art Unit 3773